

REMARKS

Claims 1-20 are pending in the present application. Claims 1, 9, and 12 have been amended to address the 35 U.S.C. §112, second paragraph issues. No new matter has been added.

Office Action of August 23, 2007

Applicant has carefully reviewed and considered the Office Action of August 23, 2007. Applicant hereby requests entry of this Response and further consideration of the present application in view of the following remarks.

Request for Clarification

In stating the rejection of claims 1-20 under 35 U.S.C. §103(a), the Examiner appears to be relying upon the *Kesling* parent application, 09/461,699, now U.S. Patent 7,010,263 (*Patsiokas*) at page 4 of the Office Action, yet does not include it in the statement of the rejection. This is error on the part of the Examiner. See *In re Hoch*, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n. 3 (CCPA 1970) ("Where a reference is relied on to support a rejection, whether or not in a 'minor capacity,' there would appear to be no excuse for not positively including the reference in the statement of the rejection."). This issue was raised in the -Appeal Brief filed December 4, 2006, in regard to the then pending anticipation rejection based upon *Kesling*. It remains unclear if and how the Examiner relies upon *Patsiokas* in the obviousness rejections based upon *Kesling* as the primary reference especially since the examiner states at page 7 of the office action that he is "unaware of any specific reference to the application of *Patsiokas*..." The Examiner's attention is again directed to page 4 of the Office action which refers to "application serial number 09461,699" which is the *Patsiokas* application.

As explained in the Appeal Brief, *Kesling* describes two broad embodiments of that invention, flash memory and wireless. It is only the wireless embodiment of *Kesling* that is relevant to the claimed subject matter under review in this application. *Patsiokas* on the other hand is limited to flash memory technology. If the Examiner remains of the opinion that the obviousness rejections based upon *Kesling* as a primary reference make any of the claims

obvious, the Examiner is respectfully asked again to clarify the rejections as to how *Patsiokas* is relied upon.

Another point that needs to be clarified is whether the Examiner is relying upon the “purchase” described in paragraph [0090] of *Kesling* in making this rejection. This issue arises since in the previous appeal (Appeal No. 2006-1365, April 27, 2006), the BPAI relied upon that portion of the reference in affirming the decision of the examiner. Slip op. at 3-4. Since the decision of the Board, the examiner has not relied upon this portion of the reference so it is not clear whether the Examiner is relying upon this portion of *Kesling* as did the Board. Thus, the Examiner is asked to clarify whether he is relying upon the “purchase” described in paragraph [0090], and if so, in what manner.

As a result of the aforementioned, it is difficult for the Applicant to respond with specificity to the rejections.

Rejections under 35 U.S.C. §112

The Examiner rejected claims 1, 9 and 12 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Applicant traverses the rejection and requests reconsideration thereof. In response to this rejection, the Applicant has amended claims 1, 9 and 12 removing the term “sufficient.”

Rejections under 35 U.S.C. §103(a)

The Examiner rejected claims 1-13 and 15-20 under 35 U.S.C. 103(a) as being unpatentable over *Kesling et al* (U.S. 2002/0132575) in view of *Borovoy* (U.S. 2003/0204446). The Applicant traverses the rejections and requests reconsideration thereof.

Prior to turning to the rejection it is helpful to review the technology encompassed by the claims under review. The present receiver receives a “purchase request” and records “purchase data.” The purchase request may be the simple act of pressing a button on the receiver. Specification, paras. [0009], [0018]. “Purchase data” are described as including “at least identification of the purchaser, such as a code, token, MIN, Pin number, or other indicia and data sufficient to identify the good or service desired purchase.” Specification, para.

[0023]. The recognition of the purchaser can be “from a specific database of purchasers, such as those signed up for the service, or those identifiable...based upon purchase data.” Specification, para. [0029]. Since the purchaser identification is “preloaded” in the system, either in the receiver and/or the server(s) that provide verification, if the broadcast media contains identification data of the good or service the user desires to purchase, see, e.g., specification, para. [0022], “the purchase information is received...and the purchase data is generated....” Specification, para. [0027]. Because of the unique nature of the “purchase data” of the present invention, the purchase of goods and services from a broadcast media stream is accomplished by simply initiating a “purchase request” and the purchase will be completed upon verification by the server(s), with no other action required by the user. In other words, the present “purchase data” and server(s) allow the purchase to be completed without “further interaction from the person to verify or follow through with the purchase.” Specification, para. [0008].

Claim 1

Kesling and Borovoy do not render claim 1 prima facie obvious

Turning to the rejection as it pertains to claim 1, as previously argued by the Applicant, *Kesling* involves a satellite radio broadcast system with a user interface 1000 that “allows the receiver to receive input from a listener/user indicating an interest in a given selection.” *Kesling*, para. [0041]. The pressing of the button 1220 selects a “program identifier” and the user receives a “media link,” which can be a physical or wireless link to more information about the program. *Kesling*, paras. [0041], [0064], [0065]. In reviewing how a user “purchases” goods and services by way of the *Kesling* system it is seen that the user cannot simply press select button 1220 of the *Kesling* receiver and purchase the desired good or service. Rather, the “purchase” of a good or service by way of the *Kesling* system requires further interaction and action on the part of the user. The *Kesling* receiver does not record “purchase data” as required by claim 1 that can be simply verified by the server(s) that receive the purchase data in order to complete the purchase.

The Examiner alleges that *Kesling* “teaches sending purchase related information back to the server using a one click method (para0065) but agrees that *Kesling* does not teach the limitation that the purchase is accomplishable without further interaction from the person.

Office action, page 5. The Examiner alleges that *Borovoy* cures the deficiency of *Kesling* that the purchase is accomplishable without further interaction from the person because *Borovoy* teaches the Amazon.com one-click method to send purchase data from a portable device to a website in a one click manner, citing paragraph [0017] of *Borovoy*.

However, curing the deficiencies of *Kesling* with *Borovoy* is not so simple. The *Borovoy* teaching of using a one-click method to send purchase data from a portable device to a website in a one click manner must be read in the context of the entire reference, not in isolation as the Examiner has done. *In re Lancer*, 465 F.2d 896, 899, 175 USPQ 169, 171 (CCPA 1972) (“when ‘all of the disclosures in a reference’ are considered, the overall suggestion to emerge from the prior art reference may be contrary to that which might appear from an isolated portion of the reference.”)

Borovoy teaches an involved method and system for purchasing goods and services that requires the interaction of a first user and a first PDA and a second user and a second PDA where the first user enters “enough data to uniquely identify a product or service to be purchased or otherwise obtained on the web. Then, when that customer or potential customer of Amazon or Yahoo wants to provide that information to another customer who has the necessary software on his PDA, she could beam it from her PDA to the other customer’s PDA.” *Borovoy*, para. [0015]. *Borovoy* also teaches that more than two PDAs may be used together. *Borovoy*, para. [0021]. In another embodiment, a PC may be used together with the second PDA. When the PDA synchs with the PC, the order may be placed using a command in the second PDA to connect to the appropriate website to place the order. *Borovoy*, para. [0022].

Borovoy teaches that the order software on the PDA may require at least one click from the recipient PDA before the order is placed, but that this feature, the one-click, is not necessary. *Borovoy*, para. [0025]. The Applicant contends that although the one-click from the recipient PDA is not necessary before the order is placed, a further interaction is required for the order to be completed. To explain, *Borovoy* teaches that the order will be “placed automatically either immediately upon receipt of the beam, if the PDA is already connected to the web, or upon connecting the PDA with the web, or automatically upon synching the PDA to a PC,” all requiring further interactions on the part of the user. Even in the embodiment where the order is placed immediately upon receipt of the beam by the second

user, the purchase can only be completed if the second user initially takes the necessary actions to receive the beam on the second PDA from the first user's first PDA. Those actions constitute further interaction from the second person.

In other words, the method and system of *Borovoy* are analogous to the flash media embodiment of *Kesling* where upon learning of goods and services that are desired to be purchased (in *Borovoy*, by way of the first user informing the second user of the goods and services), the user cannot purchase those goods and services without further interaction by the user, e.g., remove the flash media from the broadcast receiver and inserts the media into a reader. *Kesling*, [0041]. In *Borovoy*, the further interaction includes at the least the steps needed to receive the beamed information from the first PDA by the second PDA. In contrast, according to the method, receiver and system of the pending claims, the user upon first learning of the goods and services by way of the broadcast receiver can simply purchase the goods and services by submitting a purchase request without any further interaction required. Accordingly, the order of *Borovoy* cannot and does not occur without further interaction from the person placing the order as it will by the person using the Applicant's invention.

Further distinction between the respective systems, the system of *Kesling* and the technology encompassed by the claims under review is readily seen when *Kesling* is read in its entirety. For example, pressing select button 1220 is typically described by *Kesling* as only indicating listener interest in the broadcast media content and that a web site can send information about the content to the system user. *Kesling*, e.g., paras. [0048] –[0051]. In discussing “purchasing” goods and services, *Kesling* simply fails to provide sufficient details of what purchase data, if any, is generated and how a purchase is executed. An example of this deficiency is seen in the description of “purchase” at [0066] of *Kesling* where the “purchase” is premised upon the listener receiving further information. While this passage also states that the listener can “complete the transaction,” this passage does not describe the use of “purchase data” that can be verified by a server(s) of the system as required by the system of claim 1.

It is noted that the Examiner sets forth as the reason for combining *Kesling* and *Borovoy* at page 5 of the Office action based upon creating impulse sales. The Examiner is

correct that a reason for combining the references is needed. As set forth in *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385, 1396 (2007):

[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does.

Here, the examiner's reasoning based upon impulse buying lacks factual support in the record. The overall complexity of *Borovoy* and the need of two persons and PDAs interacting in the *Borovoy* system and method belie the concept of impulse purchasing. Instead it appears that the *Borovoy* system and method will result only in studied orders, not impulse buying.

The PTO has determined that *Borovoy* does not enable automatic connection to the World Wide Web.

It is also noted that in addition to *Borovoy* teaching the Amazon.com one-click method to send purchase data from a portable device to a website in a one click manner as stated by the Examiner in the Office Action, *Borovoy* also teaches an embodiment where "an order is placed automatically when the second user connects the second portable handheld PDA to the World Wide Web." See, e.g., *Borovoy*, paragraphs [0022] and [0025]. A review of the prosecution history of the *Borovoy* application on Public PAIR at www.uspto.gov, reveals that the application is abandoned for failure to respond to an Office action and no continuing applications are listed. Claim 25 of *Borovoy* reads:

25. (Previously presented) The method of claim 1 wherein the order is placed automatically when the second user connects the second portable handheld PDA to the World Wide Web.

The final rejection entered August 28, 2006, in *Borovoy* states:

Claim 25 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Regarding claim 25, the recitation "the order is placed automatically when the second user connects the second portable handheld PDA to the World Wide Web" is abstract and does not enable one skilled in the art to determine how the order is placed automatically or what causes the order to be placed automatically. How is the specially formatted description, assuming it is used to place the order, used to place the order automatically?

It is axiomatic that prior art applied under 35 U.S.C. 103(a) must be enabled. *In re Payne*, 606 F.2d 303, 314 (CCPA 1979) ("References relied upon to support a rejection under 35 USC 103 must provide an enabling disclosure, i.e., they must place the claimed invention in the possession of the public.") Since *Borovoy* is nonenabled in regard to automatically connecting to the web, it cannot cure the deficiency of *Kesling* that the purchase is accomplishable without further interaction from the person.

That *Borovoy* is non-enabled in terms of automatically connecting with the web is consistent with the position taken by Applicant in the previous appeal that *Kesling* did not enable the "purchase" described therein. Attention is drawn to the Declaration of Walter E. Thain, Jr. where Mr. Thain states his opinion based upon the facts set forth in the declaration that "pressing button 1220 does not enable a complete purchase transaction in the system described by *Kesling*...."

Applicant is aware of the Board's concern that the "lack of technical detail in the appellant's specification indicates that if one of ordinary skill in the art could carry out a radio-generated purchase based upon the appellant's disclosure at the time of appellant's invention, that person could do the same given *Kesling*'s disclosure." Slip op. at 4. In response, the Applicant contends that *Kesling* does not describe the "purchase data" required by the system of claim 1 and did not take into account that the servers of claim 1 must be able to verify the purchase data sent from the receiver(s) in order for the purchase transaction to be completed. These are features absent from the applied references but supplied by the

disclosure of this application. Thus, it is very logical that the present claims are enabled where the applied references are not.

Claim 9

Apart from the reasons set forth above in regard to claim 1, which are incorporated by reference herein, claim 9 is separately patentable for the following additional reasons.

Claim 9 is directed to a receiver for purchasing goods and services linked with broadcast media. The arguments made above in regard to claim 1 are incorporated by reference herein. Importantly, the receiver of claim 9 must be able to receive a purchase request and record the purchase data for goods and services that a person purchases linked with the broadcast media. As explained above, *Kesling* does not describe the “purchase data” required by claim 9 and *Borovoy* does not make up for this deficiency.

Claim 12

Claim 12 sets forth a method for purchasing goods and services linked with broadcast media. The method of claim 12 requires, inter alia, that the receiver receives a purchase request and records purchase data for a good and service that a person purchases relating to the broadcast media. The purchase data is sent to at least one server where the purchase data is verified. The arguments made above in regard to claim 1 are equally applicable to claim 12 and are incorporated herein by reference.

Claim 8

Specifically regarding claim 8, “each broadcast receiver is comprised of at least two devices, to include a broadcast media and a purchase selection device.” The Examiner refers to *Kesling* para. [0042] as describing the broadcast receiver of *Kesling* may include an “intermediate transfer device” as a purchase selection device. Final Rejection, page 15. This is incorrect as the “intermediate transfer device” of *Kesling* is not a purchase selection device.

As seen in the embodiment of the subject matter of claim 8 described in the present specification at page 7, the broadcast receiver does not have a purchase selection device. In contrast, the broadcast receiver of *Kesling* always has a purchase selection device, e.g., button 1220. Paragraph [0041] of *Kesling* only describes an embodiment where information stored

on a broadcast receiver having a storage selection device is transferred to an intermediate device for storage.

Clarification is needed as to where *Kesling* describes that each broadcast receiver is comprised of at least two devices, to include a broadcast media receiver and a purchase selection device. The Applicant requests the rejection be withdrawn and solicits allowance of claim 8.

Claim 20

Claim 20 depends from claim 8 and further requires that the broadcast media receiver and purchase selection device are separate. As argued above in regard for claim 8, it is not clear how *Kesling* describes that each broadcast receiver is comprised of at least two devices, to include a broadcast media receiver and a purchase selection device. Thus, it is less clear how *Kesling* teaches that these two components are separate. The Applicant requests the rejection be withdrawn and solicits allowance of claim 20.

Claims 2-7, 10, 11 and 13-19

Claims 2-7 depend from claim 1 and add further elements thereto. Claims 10-11 depend from claim 9 and add further elements thereto. Claims 13-19 depend from claim 12 and add further elements thereto. Applicant submits that, for at least the reasons stated above with respect to patentability of claims 1, 8, 9, 12 and 20, the suggested combination cannot render claims 2-7, 10-11 and 13-19 obvious. Therefore, Applicant requests the rejections be withdrawn and solicits allowance of claims 1-20.

Conclusion

In view of the foregoing remarks, Applicant respectfully submits that Claims 1-20 are in condition for allowance and entry of the present amendment and notification to that effect is earnestly requested. If necessary, the Examiner is invited to telephone Applicant's attorney (404-254-6685) to facilitate prosecution of this application.

No additional fees are believed due. However, the Commissioner is hereby authorized to charge any additional fees that may be required, including any necessary extensions of time, which are hereby requested to Deposit Account No. 23377.

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